

THIS DISPOSITION IS NOT
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THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

ESPN, Inc.
v.
Kurt Luttermoser

Opposition No. 91158096
to application Serial No. 78152001
filed on August 7, 2002

Robert L. Raskopf, Claudia T. Bogdanos and Jessica A. Rose
of White & Case for ESPN, Inc.

Jeffrey H. Greger of Lowe Hauptman Gilman & Berner LLP for
Kurt Luttermoser.

Before Hairston, Bucher and Zervas, Administrative Trademark
Judges.

Opinion by Hairston, Administrative Trademark Judge:

Kurt Luttermoser has filed an application to register
the mark A GAMES (in standard character form) for
"entertainment services in the nature of a live sporting
event featuring aggressive in-line skating, skateboarding,

sky-diving, motor cross racing, barefoot water skiing, wakeboarding, wave runner racing and mountain biking."¹

ESPN, Inc. has opposed registration of applicant's mark. Opposer alleges that since prior to the filing date of applicant's application, opposer has used the "trademark X GAMES and related variations thereof" to "brand a sports competition featuring skateboarding, snowboarding, mountain biking, motor cross racing, in-line skating, wakeboarding, sport climbing, surfing, skiing, and snow mobiling;" that opposer, its business partners, and licensees have expended considerable time, effort and money in advertising and publicizing the sale of goods and services bearing the X GAMES marks; that opposer's X GAMES marks are famous; that the marks became famous prior to the filing date of applicant's application; and that applicant's mark A GAMES, if used on the identified services, so resembles opposer's X GAMES marks as to be likely to cause confusion, to suggest a false connection with opposer, and to dilute opposer's X GAMES marks. Opposer pleaded ownership of the following registrations:

Registration No. 2,089,996 issued August 19, 1997 for the mark X GAMES (standard character form) for "organizing and conducting competitions featuring a wide variety of sports; an ongoing television series featuring a wide variety of sports events"

¹ Serial No. 78152001, filed on August 7, 2002, which is based on an allegation of a bona fide intention to use the mark in commerce. The word GAMES is disclaimed apart from the mark as shown.

(combined affidavit §§8 & 15; GAMES is disclaimed);

Registration No. 2,104,924 issued October 14, 1997 for the mark shown below,



for "wearing apparel, namely, shirts, T-shirts, sweatshirts, sweatpants, tank tops, tops, hats, caps, shorts, pants, jackets, neckties, belts, blouses, coats, dresses, pajamas, footwear, socks, underwear, bandannas, headbands, neckbands, wristbands, beach wear, swim wear, vests, gloves, mittens, skirts, scarves, sleepwear and sun visors" (combined affidavit §§8 & 15; GAMES is disclaimed);

Registration No. 2,126,126 issued December 30, 1997 for the mark X GAMES (standard character form) for "wearing apparel, namely, shirts, T-shirts, sweatshirts, sweatpants, tank tops, tops, hats, caps, shorts, pants, jackets, neckties, belts, blouses, coats, dresses, pajamas, footwear, socks, underwear, bandannas, headbands, neckbands, wristbands, beach wear, swim wear, vests, gloves, mittens, skirts, scarves, sleepwear and sun visors" (combined affidavit §§8 & 15; GAMES is disclaimed);

Registration No. 2,061,218 issued May 13, 1997 for the mark shown below,



for "organizing and conducting competitions featuring a wide variety of sports; an ongoing television series featuring a wide variety of sports events" (combined affidavit §§8 & 15); and

Registration No. 2,211,559 issued December 15, 1998 for the mark X GAMES (standard character form) for "computer game and video game software" (combined affidavit §§8 & 15; GAMES is disclaimed).

Applicant, in his answer, has denied the salient allegations of the notice of opposition.

The record includes the pleadings and the file of the opposed application. As its case-in-chief, opposer submitted the testimony depositions, with exhibits, of Holland Campbell, its trademark counsel and Ronald Butters, professor of English and cultural anthropology at Duke University; and notices of reliance on the discovery deposition of applicant, with exhibits, and certified copies of the pleaded registrations and a state trademark registration. For his part, applicant submitted, pursuant to the parties' stipulation, Internet printouts; and a notice of reliance on copies of third-party registrations for marks that include the word GAMES or the letter "X" for sports-related goods and/or services. As rebuttal, opposer submitted, pursuant to the parties' stipulation, the affidavit of Holland Campbell.

Briefs have been filed, but no oral hearing was requested.

Preliminary matters

We first turn to several preliminary matters. Applicant has objected to the rebuttal testimony of Ms. Campbell concerning the attendance at opposer's X GAMES competitions as improper rebuttal. Opposer, however, argues that this testimony sets forth additional facts concerning the strength of opposer's X GAMES marks and therefore rebuts the third-party registrations introduced by applicant to show that opposer's X GAMES marks are weak. Applicant's objection is sustained. The testimony concerning the attendance at opposer's X GAMES competitions does not deny, explain, or otherwise discredit the third-party GAMES registrations. Rather, the testimony clearly goes to the strength of opposer's X GAMES mark and is properly part of opposer's case-in-chief.

In addition, applicant objects to the rebuttal testimony of Ms. Campbell concerning the viewership of cable television audiences for opposer's 2001 and 2004 X GAMES competitions on the ground of hearsay. Ms. Campbell testified that the source of her knowledge was research she conducted and conversations she had with others. Applicant's objection to this testimony is likewise sustained. There is nothing in Ms. Campbell's affidavit or her prior testimony to indicate that she had anything to do with preparing the viewership figures. Thus, no proper

foundation was laid for Ms. Campbell's knowledge of the viewership figures, and in the absence of such a foundation, the testimony is hearsay.

Lastly, opposer maintains that applicant has conceded all the issues in this proceeding, with the exception of the strength or weakness of opposer's X GAMES marks. In support of this contention, opposer relies on statements applicant made in his motion to compel discovery. Suffice it to say that we do not view such statements, which were made in the context of a motion to compel the production of trademark search reports, as a concession of all the issues herein, with the exception of the strength or weakness of opposer's X GAMES marks.

The Parties

Opposer took the testimony of its trademark counsel, Holland Campbell. Ms. Campbell testified that the X GAMES are action sports competitions featuring such sports as skate boarding, in-line skating, surfing, BMX biking, snow boarding, free-style skiing and ice climbing. The X GAMES were launched in 1996 as the nation's first large scale organized action sports competitions. They also were the first nationally televised competition devoted exclusively to action sports. The X GAMES are now held annually in both summer and winter. They are broadcast on opposer's ESPN and ESPN2 networks and its affiliate network ABC. The X GAMES

are broadcast in 170 countries in 28 different languages. In the summer of 2003, 170 hours of X GAMES programming aired in the United States.

Opposer promotes the X GAMES events on its EXPN radio network, a nationally syndicated radio network that provides coverage of the X GAMES competitions to over 60 affiliates nationwide and in opposer's ESPN magazine, a bi-weekly publication. Opposer also promotes the X GAMES on its EXPN.com website which is dedicated solely to the X GAMES competitions and action sports. This website received over 3.4 million hits in the first nine months of 2004. Opposer advertises the X GAMES on television and radio and in newspapers and magazines. According to Ms. Campbell, opposer spends "several million annually in advertising." (Campbell dep. at p. 25). Opposer also licenses use of the X GAMES marks worldwide on clothing, athletic equipment, games, toys, beverages, food, posters and video games. During her testimony deposition, Ms. Campbell introduced copies of over 100 print and online newspaper articles dated from June 1996 to August 2003 about the X GAMES. The articles appeared in newspapers published across the United States, including Philadelphia, New York, Los Angeles, Dallas and Denver.

The information we have about applicant, Kurt Luttermoser, comes from his discovery deposition. For a number of years, Mr. Luttermoser has worked in sports marketing and event planning. In 2001, Mr. Luttermoser created a business plan entitled "Adrenalin Games Festival" for a televised competition involving action sports. Mr. Luttermoser testified that he came up with A GAMES as a mark for the action sports competitions, and that the A stands for "adrenalin," as well as "alternative," "action," "amateur," and "athlete." (Luttermoser dep. at p. 29). The business plan identifies opposer's X GAMES as a "main competitor." (Dep. Exhibit 5). Further, according to the business plan, the target customers of applicant's action sport competitions are young athletes. Mr. Luttermoser testified that he also intends to use the A GAMES mark on sports merchandise such as hats and T-shirts to promote the action sports competitions.

Section 2(d) Priority

There is no issue with respect to opposer's priority. Indeed, applicant states that he does not contest opposer's priority. (Applicant's brief at p. 2). In any event, opposer has proven its priority by making of record certified copies of its pleaded registrations for its

X GAMES marks and the goods and services therein. See King Candy Co. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Likelihood of Confusion

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in In re E. I. duPont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, In re Majestic Distilling Company, Inc., 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, In re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

At the outset, we note that for purposes of our likelihood of confusion analysis, the most relevant of opposer's pleaded registrations is Registration No. 2,089,996 for X GAMES in standard character form for "organizing and conducting sports competitions featuring a wide variety of sports; an ongoing television series featuring a wide variety of sports events." There is no question that applicant's services, as identified in the

application, "entertainment services in the nature of a live sporting event featuring aggressive in-line skating, skateboarding, sky-diving, motor cross racing, barefoot water skiing, wakeboarding, wave runner racing and mountain biking," are encompassed by the services identified in opposer's registration, and thus the services are legally identical. As noted, applicant identified opposer's X GAMES as a main competitor. Further, the parties' respective services would be offered through the same trade channels to the same classes of purchasers. Thus, the duPont factors which pertain to the similarity or dissimilarity of the goods, and the similarity or dissimilarity of the trade channels favor opposer.

The next factor we consider is the fame of opposer's X GAMES mark. Fame for likelihood of confusion purposes arises "as long as a significant portion of the relevant consuming public . . . recognizes the mark as a source indicator." *Palm Bay Imports, Inc. v. Veuve Cliquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005). Thus, in determining fame, we look to the class of customers and potential customers of a product or service, and not the general public. Here, the relevant consuming public comprises prospective and actual attendees and viewers of action sports competitions. After careful consideration of all the evidence on this issue, we

find that opposer has not established that its X GAMES mark is a famous mark. Here, opposer has used its X GAMES mark for ten years. However, there is no evidence properly of record with respect to income earned by opposer, or the attendance at and viewership of opposer's X GAMES over this period. Moreover, opposer's advertising figures of "several million annually" do not rise to the level normally found in connection with famous marks. There also is no evidence of public acclaim or of awards given to opposer's X GAMES broadcasts. See *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002). In sum, the evidence of fame in this record is not of the nature of that in other cases where the marks have been found to be famous. *Id.*; and *Kenner Parker Toys, Inc. v. Rose Art Industries Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992).

Further, contrary to opposer's contention, applicant's statement in his discovery deposition that opposer's X GAMES are the "Superbowl" of extreme sports is not an admission that X GAMES is a famous mark. It was opposer's burden to establish that its X GAMES mark is famous, and while the evidence is sufficient to show that opposer's mark is well known in the action sports field, it fails to establish that the mark is a famous mark that should be accorded a wide scope of protection. We conclude therefore that the factor of fame is neutral in this case.

The factor of the variety of goods on which opposer's mark is used favors opposer. The record shows that opposer and/or its licensees use the X GAMES mark on a variety of goods, including clothing, athletic equipment, games, toys, beverages, food, posters, and video games.

Finally, we turn to a determination of what we find to be the key likelihood of confusion factor in this case, i.e., whether applicant's mark and opposer's mark, when compared in their entireties in terms of appearance, sound, meaning and commercial impression, are similar or dissimilar.

To support its contention that the respective marks are similar, opposer relies heavily on the testimony of Ronald Butters, a professor of English and cultural anthropology at Duke University. Opposer points to Mr. Butters' testimony that there "is a high degree of similarity in several dimensions between these two words or these two marks."

(Dep. at p. 21). With respect to pronunciation, Mr. Butters testified that "X Games and A Games ... have identical phonemes at the end and virtually identical phonemes at the beginning." (Dep. at p. 23). In terms of meaning, Mr. Butters testified that due to the shared use of the term "games" the marks are identical in term of meaning. (Dep. at p. 27).

The testimony of Mr. Butters is essentially of no probative value. As pointed out by our primary reviewing court in *The Quaker Oats Company v. St. Joe Processing Company, Inc.*, 232 F.2d 653, 109 USPQ 390, 391 (CCPA 1956):

In this respect, it has been held that [expert] testimony amounts to nothing more than an expression of opinion by the witness, which obviously is not binding upon either the tribunals of the Patent Office or the courts. (citations omitted). If such testimony were adopted without considering other aspects of the case, the effect would be to substitute the opinion of the witnesses for the ultimate decision to be reached by the Court and would therefore be improper.

See also *Tanners' Council of America, Inc. v. Scott Paper Co.*, 185 USPQ (TTAB 1975); and *Ferro Corp. v. Nicofibers, Inc.*, 196 USPQ (TTAB 1977). In short, the Board must reach its own conclusions on the ultimate issues before it, including whether the marks are similar or dissimilar.

Here, it is obvious that the marks are similar in terms of sight, sound and meaning to the extent that they both include a single letter followed by the word GAMES. However, it is equally obvious that the marks are dissimilar in terms of sight, sound, and meaning to the extent that they start with different letters that are readily distinguishable, i.e., the letters X and A. It is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered. See *Presto*

Products Inc. v. Nice-Pak Products Inc., 9 USPQ2d 1895 (TTAB 1988).

In terms of meaning, in particular, it is likely that the letter X in opposer's mark would be viewed as suggesting "extreme," as in "extreme sports". In this regard, we note the following excerpts from the newspaper articles introduced by opposer which discuss opposer's X GAMES and reference extreme sport(s):

The X Games, a nontraditional festival of "extreme" or action sports ...

(New York Times, August 5, 2001);

X-Gamers vow the Winter Olympics can't hold a torch to their extreme sports.

(Denver Rocky Mountain News, January 18, 2002);

and

A Winter version of the X Games, the extreme sport competition staged last summer by ESPN ...

(Denver Post, January 30, 1997).

In contrast, the letter A in applicant's mark is not likely to suggest "extreme." Rather, it is likely to suggest "adrenalin(e)" if used with "Adrenalin Games Festival" or perhaps "alternative," "action," "amateur," and "athlete." We find that the marks are dissimilar in terms of overall commercial impression, notwithstanding that they both include the word GAMES. We judicially notice that "game" is defined, inter alia, as "any specific contest, engagement, amusement, computer simulation, or sport involving physical or mental competition under specific rules, as football, chess or war games." Webster's New

World College Dictionary (Third edition 1997). In both parties' marks, GAMES connotes sports competitions. Thus, at a minimum, the term is descriptive as used in connection with the services. The descriptive nature of the term is corroborated by the fact that the parties have disclaimed the word as well as by the disclaimers that appear in the third-party registrations of GAMES marks that applicant has made of record. Consequently, the mere facts that applicant's mark incorporates the same term and has the same format of a letter followed by GAMES does not mean that applicant's mark is sufficiently similar in meaning, or projects a similar commercial impression to opposer's mark. Instead, when considered in their entirety, applicant's A GAMES mark is different from opposer's X GAMES mark and the dissimilarities in the marks outweighs all other relevant du Pont factors. *Kellogg Co. v. Pack'Em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991).

Accordingly, contemporaneous use of the parties' marks in connection with legally identical services is not likely to cause confusion as to origin or affiliation.²

The False Suggestion of A Connection and Dilution Claims

We have already found that applicant's A GAMES mark is

² We should add that even if opposer had established that its X GAMES mark is famous, the result here would be the same. That is, the factor of fame is not sufficient to establish likelihood of confusion in this case.

not similar to opposer's X GAMES mark for purposes of likelihood of confusion. Also, opposer has not proven that applicant's A GAMES mark is the same as or a close approximation of opposer's X GAMES mark, an element that is required in order to prevail on a false suggestion of a connection claim. See *In re Sloppy Joe's International Inc.*, 43 USPQ2d 1350 (TTAB 1997). Similarly, opposer has not proven that the marks are identical or substantially similar as required for purposes of dilution. See *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164 (TTAB 2001).

Decision: The opposition is dismissed.